

AMENDMENTS TO THE DRAWINGS:

The attached sheet of drawings includes changes to Figure 1. This sheet, which includes Figure 1, replaces the original sheet including Figure 1. The Figure has been amended to include English language references. The Applicants submit that no new matter has been added.

Attachment: Replacement Sheets

REMARKS

In the Office Action mailed August 22, 2008 the Office noted that claims 1-40 were pending and rejected claims 1-40. Claims 1, 17 and 26 have been amended, claims 10, 22, 31 and 34 have been canceled, and, thus, in view of the foregoing claims 1-9, 11-21, 23-30, 32, 33, 35-40 remain pending for reconsideration which is requested. No new matter has been added. The Office's rejections and objections are traversed below.

OATH/DECLARATION

The Office states that the 3<sup>rd</sup> page of the Declaration is missing from the file. The Declaration, pages 1-3, is submitted in the appendix of this paper.

OBJECTION TO THE DRAWINGS

The drawings stand objected to. In particular the Office asserts that the legends are not English. The Applicants submit new drawings herewith. The Applicants submit that no new matter has been added by the amendment of the drawings.

Withdrawal of the objection is respectfully requested.

REJECTIONS under 35 U.S.C. § 101

Claims 1-25 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular the Office asserts that the method claim 1 is software per se as

it recites steps which do not produce a useful, concrete and tangible result; and that claim 17 lacks and physical objects to constitute a machine or manufacture.

Claims 1-16 are rejected under 35 U.S.C. § 101 because it is asserted that the claims are directed to non-statutory subject matter as not producing a "useful, concrete tangible result." Applicant traverses this rejection for the following reasons:

- Claims 1-16 are directed to a process which is statutory subject matter ("process" as defined in 35 U.S.C. §101) and therefore the "useful, concrete and tangible result test" should not be applied; and
- The method claimed in claims 1-16 does achieve a "useful, concrete and tangible result."

According to the Guidelines, the first step in determining utility of a claim is to determine whether the claim is directed toward at least one of the enumerated subject matter categories – process, machine, manufacture or composition of matter. If the claims are not directed to one of the categories enumerated in 35 U.S.C. § 101, it should be determined whether the claim is directed to a law of nature, natural phenomena or abstract idea which constitute subject matter to which a judicial exception may apply. Finally, if it is determined that the claims are directed to one of the above-mentioned categories, PTO has proposed two ways to determine whether the claims are susceptible of an application of a § 101 judicial exception:

1. The claimed invention "transforms" an article or physical object to a different state or thing.
2. The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

Claims 1-16 are directed to a method, so that the subject matter corresponds to a "process" as recited in 35 U.S.C. §101. Therefore, applying the judicial exception test "useful, concrete and tangible result" is not an issue for these claims.

While the Applicants need not apply the useful, concrete and tangible test as a method is per se statutory. The Applicants submit that "calculating and storing a second signature (SIG2) representative of the execution of the set of instructions," is useful, concrete and tangible. As both calculating and storing are useful, concrete and tangible acts.

Claims 17-25 are rejected under 35 U.S.C. § 101 as non-statutory. In particular the Examiner states that the claims contain no physical embodiment. The Applicant has amended the claim 17 to recite "the first signature (SIG1) stored in a memory." Support for the amendment may be found, for example in claim 7 or Fig. 3 of the Specification. The Applicant submits that no new matter has been added by the amendment to claim 17.

MPEP 2601(IV)(B)(2)(a) states "[i]f a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory

product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760." Claim 17 defines "a memory", which is hardware and therefore statutory.

Withdrawal of the rejections is respectfully requested.

REJECTIONS under 35 U.S.C. § 112

Claim 31 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In particular, the Office asserts that claim 31 contains a contradiction with claim 26. The Applicant has cancelled claim 31 and amended claim 26 to recite "means (22) for calculating and storing in *said first register (REG1) or in a second storage register (REG2)* during the execution of the set of instructions a second signature (SIG2) representative of the execution of the set of instructions." Support for the amendment may be found, for example, in cancelled claim 31 or in the Specification, page 32, lines 12-19. The Applicants submit that no new matter has been added by the amendment of claim 26.

Withdrawal of the rejection is respectfully requested.

REJECTIONS under 35 U.S.C. § 102

Claims 1-40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Naccache, U.S. Patent No. 7,168,065. The Applicants respectfully disagree and traverse the rejection with

an argument and amendment.

Naccache discusses that a set of instructions that do not include any jumps within the sequence of instructions. A conditional jump being only allowable at the end of a sequence (see col. 14, lines 8-11), since the use of the jump instructions within the sequence of instructions is not compatible with the disclosed method for verifying computer program execution within a signature.

To emphasize this point the Applicants have amended the independent claims to recite "said set of instructions comprising at least one critical instruction in the form of a jump instruction of any type (JMP, JNZ, CJNE, JZ) within the sequence of instructions of said set of instructions." Support for the amendment may be found, for example, in cancelled claim 10 and on page 8, lines 9-11 of the Specification. The Applicants submit that no new matter has been added by the amendment of claims 1, 17 and 26.

On page 9 of the Office Action it is asserted that Naccache, col. 14, line 10 discloses such a feature. However, Naccache, col. 14, lines 8-13 state

The three sets of instructions EI1, EI2 and EI3 **do not include any jumps within their sequence** of instructions. (In the case of the first set of instructions, the conditional jump to the instruction EI1-j is at the end of the sequence.) Thus, for each of the three sets of instructions, all the instructions are designed to be executed sequentially as from the first. [Emphasis added]

Thus, Naccache, discusses that the set of instructions **do not**

include any jumps within their sequence of instructions. A conditional jump only being allowable at the end of the sequence, since the use of jump instructions is not compatible with the method discussed in Naccache for verifying computer program execution with a signature.

For at least the reasons discussed above, claims 1, 17 and 26, and the claims dependent therefrom are not anticipated by Naccache.

Withdrawal of the rejection is respectfully requested.


SUMMARY

It is submitted that the claims satisfy the requirements of 35 U.S.C. §§ 112 and 102. It is also submitted that claims 1-9, 11-21, 23-30, 32, 33, 35-40 continue to be allowable. It is further submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item(s):

- ☐ - a new or amended Abstract of the Disclosure
- ☒ - Replacement Sheets for the drawing Figures
- ☐ - a Substitute Specification and a marked-up copy of the originally-filed specification
- ☐ - a terminal disclaimer
- ☒ - a 37 CFR 1.132 Declaration
- ☐ - a Substitute Specification and a marked-up copy of the originally-filed specification
- ☐ - a verified English translation of foreign priority document